REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

Claims 1-8 were pending in this application. In this response, claims 1, 2, and 5 are amended, claims 9-14 are added, and no claim is cancelled. Thus, claims 1-14 are pending.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims, Figures 1, 4, and 5, and the specification, page 3, line 30 – page 4, line 9, page 4, line 26 – page 5, line 36.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 1, 2, 4, 5 and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by (RE. 21068) to Miller (hereafter "*Miller*") on the grounds set forth at page 2 of the Official Action. The Examiner alleges that *Miller* discloses a screw (20) that represents both a fastener integrated with the cutting head intended to be received in a tool coupling, and means to adjust the positions of the appurtenant cutting inserts. The Examiner further alleges that *Miller* discloses at least two insert seats and cutting inserts in a cutting head.

Applicants respectfully traverse the rejection. To establish a *prima facie* case of anticipation, a single prior art reference must teach each and every element of the claimed invention, either explicitly or inherently. *Verdegaal Bros. v. Union Oil Co. Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants submit that *Miller* fails to disclose at least the following elements of claim 1:

1) "a fastener integrated with the cutting head, which fastener is intended to be received in a tool coupling;"

2) "the cutting head being provided with at least two insert seats, and cutting inserts being mounted in the insert seats wherein the insert seats are provided with first serrations;" and

3) "means are arranged to apply a force to the appurtenant cutting insert in the axial direction of the slot milling cutter in order to adjust the position of the cutting insert."

The Examiner alleges that the set screw (20) of *Miller* is a fastener integrated with the cutting head intended to be received in a tool coupling. The fastener recited in claim 1 is integrated with the cutting head, and is intended to be received in a tool coupling. The fastener is intended to be the mechanism that attaches the slot milling cutter to the tool coupling in a machine. The set screw (20) of *Miller* is installed in the transverse rib or boss (18) of a wedge block (14) used in *Miller* to press the cutting insert against the serrated surface within the slot (11). Therefore, the set screw (20) is not a fastener intended to be received in a tool coupling as recited in claim 1. Further, *Miller* fails to disclose a fastener integrated with the cutting head.

The Examiner fails to clearly articulate what is considered in *Miller* to represent the cutting head recited in claim 1. It appears the Examiner considers the cutting body (10), or at least some portion of the cutting body (10) such as the slot (11), to be the claimed cutting head. However, the cutting body (10) is not a cutting head that is attached to a machine via a fastener that is integral with the cutting head. If the cutting head of the claims is intended to be represented by the slot (11), then there is only one insert seat on the cutting head that is provided with first serrations. Therefore, *Miller* fails to disclose a cutting head that is connected to a machine by an integral fastener received in a tool coupling, and that contains at least two insert seats, which are provided with first serrations.

Finally, the Examiner fails to disclose a means arranged to apply a force to the appurtenant cutting insert in the axial direction of the slot milling cutter. The Examiner alleges

that the set screw (20) is a means to adjust the position of the appurtenant cutting inserts. However, the set screw (20) does not apply a force to the blade (12) in the axial direction of the cutter (10). The set screw (20) applies a force to the blade (12) in a direction transverse to the axial direction of the cutter (10) to tighten the blade (12) against the serrated surface of slot (11). Therefore, *Miller* fails to disclose at least this element of claim 1.

For at least the reasons presented above, *Miller* fails to disclose each and every element of claim 1, and thus the rejection is improper. Dependent claims 2-4 and 9-14, which depend from claim 1, are also not anticipated for at least reasons similar to those for claim 1. For at least these reasons the rejection should be withdrawn.

Applicants further submit that *Miller* fails to disclose at least "the cutting insert having at least one toothed edge side" as recited in claim 5. *Miller* discloses a smooth blade for the cutting insert installed in the cutting body, and fails to disclose any toothed edge side. *Miller* contains only one surface with serrations, while claim 5 recites at least one surface with serrations and another edge side that is toothed. Therefore, *Miller* fails to disclose at least "the cutting insert having at least one toothed edge side" as recited in claim 5, and thus the rejection is improper. Dependent claims 6-8, which depend from claim 5, are also not anticipated for at least reasons similar to those for claim 5. For at least these reasons the rejection should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 3 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Miller* in view of WO 2004/062839 to Sakamoto et al. (hereafter "*Sakamoto*") on the grounds set forth at page 3 of the Official Action. The Examiner alleges that *Sakamoto* provides a suggestion to modify *Miller* to contain serrations on both main surfaces of the cutting insert.

Applicants respectfully traverse the rejection. Claims 3 and 6 depend on claims 1 and 5, respectively. As presented above, *Miller* at least fails to disclose or suggest each and every element of either claim 1 or claim 5. The Examiner appears to rely on *Sakamoto* solely for elements presented in claims 3 and 6, and Applicants submit that *Sakamoto* fails to cure the deficiencies of *Miller* regarding claims 1 and 5. Therefore, for at least this reason *Miller* and *Sakamoto* fail to teach all of the elements recited in claims 3 and 6. Accordingly, Applicants respectfully request withdrawal of the rejections.

Claims 3 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Miller* in view of U.S. Patent No. 4,946,318 to David et al. (hereafter "*David*"). Applicants note that it appears the Examiner intended to reject claim 8 using the combination of *Miller* and *David*, and not claims 3 and 6, because the Examiner refers to two opposed toothed edge sides, which is recited in claim 8.

Regardless of which was intended, Applicants respectfully traverse the rejection. Claim 3 depends on claim 1. As presented above, *Miller* at least fails to disclose or suggest each and every element of claim 1. The Examiner appears to rely on *David* solely for elements presented in claim 3 (actually it appears for elements presented in claim 8), and Applicants submit that *David* fails to cure the deficiencies of *Miller* regarding claim 1. Therefore, for at least this reason *Miller* and *David* fail to teach all of the elements recited in claim 3. Accordingly, Applicants respectfully request withdrawal of the rejection.

With regard to claim 6, *David* provides no main surface with serrations much less both main surfaces, and thus does not provide any suggestion to one of ordinary skill in the art to modify *Miller* to include serrations on both main surfaces of the insert seat.

With regard to claim 8, which is the claim the Examiner appears to have intended to reject, there is no reason for one of ordinary skill in the art to modify *Miller* to include two opposed toothed edge sides as suggested by the Examiner. The Office's objective analysis of obviousness should be made explicit. *See KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385, 1396 (2007). The Examiner alleges that it would be obvious to modify *Miller* to include two opposed toothed edges in order to provide an indexing capability to the tool when the edges are worn. This rationale might render the proposed modification of *Miller* obvious if *Miller* disclosed one toothed edge, but *Miller* fails to disclose any toothed edge. Applicants also submit that *David* also fails to disclose a toothed edge, and certainly not a toothed edge parallel to the serrations on a main surface. The serrations in *Miller* run parallel to the longest side of the blade (12), whereas the only portion of *David* that could possibly be considered a tooth is on the short end of the insert. Therefore, any combination of *Miller* and *David* would include a toothed edge side that is not parallel to extension of the serrations as recited in claim 5. Therefore, for at least this reason *Miller* and *David* fail to teach all of the elements recited in claim 5 or claim 8. Accordingly, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP

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By: Christopher P. Bruenjes
Reg. No. 62,941

CUSTOMER NO. 055694
DRINKER, BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, D.C. 20005-1209
Tel: (202) 842-8800
F: (202) 842-8465